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Attorney Docket No. P25052

In re application of: **H. PFEILER**

Application No. : 10/804,132

Filed : March 19, 2004

For : **DEVICE AND METHOD FOR CONNECTING THE FACES OF PARTS**

Mail Stop Amendment
 Group Art Unit: 1725

Examiner: J. J. Johnson

Mail Stop Amendment

Commissioner for Patents
 U.S. Patent and Trademark Office
 Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Sir:

Transmitted herewith is an **Election with Traverse** in the above-captioned application.

☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

☐ A Request for Extension of Time.

☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 42	*42	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 4	**4	0	x 44=	\$	x 88=	\$0.00
Multiple Dependent Claims Presented			+150=	\$	+300=	\$0.00
Extension Fees for ____ Month(s)				\$		\$0.00
Total:				\$	Total:	\$0.00

* If less than 20, write 20

** If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$ ____.

☐ A check in the amount of \$ ____ to cover the *filing/extension* fee is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).

Neil F. Greenblum
 Reg. No. 28,394

Robert W. Mueller
 Reg. No. 35,043



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Hans PFEILER Confirmation No. 6384
Serial No : 10/804,132 Group Art Unit: 1725
Filed : March 19, 2004 Examiner: J. J. Johnson
For : DEVICE AND METHOD FOR CONNECTING THE FACES OF PARTS

ELECTION WITH TRAVERSE

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Amendment
Randolph Building
401 Dulany Street
Alexandria VA 22314

Sir:

In response to the Examiner's restriction requirement of September 20, 2005, the time set for response being one month, i.e., October 20, 2005, Applicant hereby elects the invention of Group II directed to the method of joining parts by friction welding. While the Examiner identified claims 33-51 as directed to the method, Applicant notes that claims 31-51 and 53 are directed to the method and are hereby elected. Moreover, Applicant elects the Species IIa directed to claims 34 and 35, with claims 33 and 53 being identified as generic. Further, Applicant notes claims 31 and 32 are also generic.

Thus, Applicant requests examination of at least method claims 31-35 and 53. The above election is made with traverse for the reasons set herein below:

In the Official Action of September 20, 2005, the Examiner indicated that all claims (i.e., claims 13-54) were subject to restriction under 35 U.S.C. § 121. The Examiner

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restricted the claimed invention into Group I, including claims 13-32 and 52-54 drawn to a device for joining, classified in class 156, subclass various, and Group II, including claims 33-51, drawn to a method of joining, classified in class 228, subclass 112.1.

The Examiner asserted that the inventions were related as process and apparatus for its practice, and that the inventions are distinct from each other under M.P.E.P. § 806.05(e) because "the apparatus can be used in adhesive bonding."

In addition to the restriction, the Examiner indicated that an election of one of the following species would also be required of Group I was chosen:

Species Ia drawn to claims 14 and 17-19;

Species Ib drawn to claims 15 and 16;

Species Ic drawn to claims 20-30; and

Species Id drawn to claims 31 and 32.

The Examiner noted that claims 13, 52 and 54 were generic.

The Examiner also indicated that an election of one of the following species would also be required of Group II was chosen:

Species IIa drawn to claims 34 and 35;

Species IIb drawn to claims 36 and 37;

Species IIc drawn to claims 38-47;

Species IId drawn to claims 48 and 49;

Species IIe drawn to claims 50 and 51.

The Examiner noted that claims 33 and 53 were generic.

Applicant respectfully submits that the species election is improper with regard to

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Group II inasmuch as each of the method claims is directed to friction welding ends of parts and because each dependent claim does not preclude coverage for features recited in other dependent claims so as to justify a species restriction.

Furthermore, Applicant respectfully submits that the Examiner has omitted one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. That is, as set forth in M.P.E.P. § 803, "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if the restriction requirement were not required.

While the Examiner has alleged a possible distinction between the two identified groups of invention, the Examiner has not shown that a concurrent examination of these groups, and each species, would present a "serious burden." In fact, the Examiner has failed to specify any appropriate statement that the search areas required to examine the invention of Group I would not overlap into the search areas for examining the invention of Group II, and vice versa.

Accordingly, Applicant respectfully submits that the search for the combination of features recited in the claims of the above-noted groups, and the individual species, if not totally co-extensive, would appear to have a very substantial degree of overlap. Because the search for each group and species of invention is substantially the same, Applicant submits that no undue or serious burden would be presented in concurrently examining Groups I and II (including each identified species). Thus, for the above-noted reasons, and consistent with the Office policy set forth above in M.P.E.P. § 803, Applicant respectfully requests that the Examiner reconsider and withdraw the restriction and species

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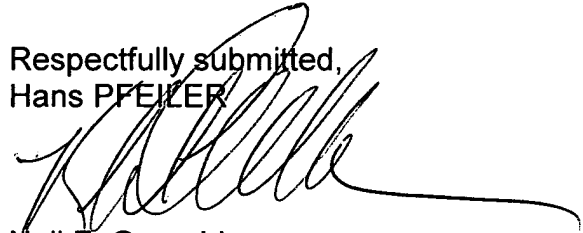
requirement in this application.

For all of the above reasons, the Examiner's restriction is believed to be improper. Nevertheless, Applicant has elected, with traverse, the invention defined by Group I and the species encompassing claims 34 and 35, i.e., claims 33-35 and 53, in the event that the Examiner chooses not to reconsider and withdraw the restriction or species requirement.

Please charge any additional fees necessary for consideration of the papers filed herein and refund excess payments to Deposit Account No. 19-0089.

Should the Examiner have any questions or comments, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
Hans PFEILER



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October 19, 2005
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